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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/938,735 | 08/27/2001 | Takashi Saito | 053969-0129 | 2749 |
| 22428 | 7590 | 06/30/2004 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | | PAYNE, DAVID C |
| ART UNIT | | PAPER NUMBER | | |
| | | 2633 | | |

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/938,735 | SAITO, TAKASHI |
| | Examiner David C. Payne | Art Unit 2633 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 August 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/19/04, 8/27/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

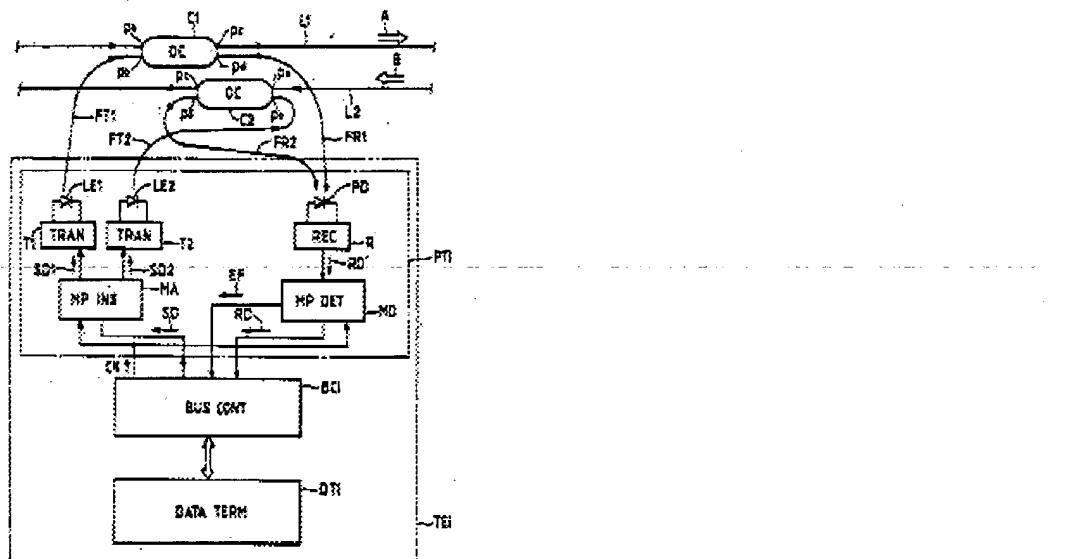
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5-9, 11, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaharu et al. US 5,130,836 (Kaharu).

FIG. 3



Re claims 1, 3, 6, 7, 9 and 12 Kaharu disclosed

An optical transmission system (apparatus /monitoring method, external conducting means), comprising an optical communication apparatus, a communicating party of said optical communication apparatus, and a monitor (PTi of Figure 3) for performing monitoring of

optical signals transmitted (A of Figure 3) and received (B of Figure 3) between said optical communication apparatus (left of Figure 3) and said communicating party (right of Figure 3); wherein said optical communication apparatus comprises: optical branching means (C1 and C2 of Figure 3) for branching optical signals to be transmitted to said communicating party (left of Figure 3) and optical signals received from said communicating party (left of Figure 3); and conducting means for conducting said optical signals to be transmitted and said received optical signals that have been branched by said optical branching means, to said monitor, and said monitor performs monitoring of the data contents of said optical signals to be transmitted and said received optical signals that have been conducted from said conducting means (e.g., col./line: 3/50-67).

Re claims 5, 8, 11 and 14 Kaharu disclosed
wherein said data contents are signaling information necessary for data exchange (e.g.,
col./line: 5/10-35).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 4, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaharu et al. US 5,130,836 (Kaharu).

Re claims 2, 4, 10 and 13 Kaharu does not disclose wherein said monitor consists of two mutually independent monitors: a monitor for performing monitoring of the data contents of said optical signals with separate interfaces. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use separate monitors if for example monitoring occurred in separate locations or by different operators. Furthermore, making parts separable is not patentable over the prior art.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fujisawa US6317055B1, Tanson US 4,736,464, Lebby et al. US005218465A, Skrobko US005442472A, and Uehara US006335810B1 all disclosed monitoring devices of optical communications systems.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Payne whose telephone number is (703) 306-0004. The examiner can normally be reached on M-F, 7a-4p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (703) 305-4729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dcp



JASON CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600